

REMARKS

Upon entry of the instant amendment claims 11, 13-14 and 16-18 will remain pending in the above identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, the recitation of a "polymerization initiator" in pending claims 17-18 finds support at page 9, line 24 of the original specification. Other changes to the claims merely change the transitional phrase to "consisting of" (see claim 11), or simply serve to put the claims into a better format for issuance in a United States Patent. Also, the limitations previously recited in claim 15, are now present in claim 11. Claims 12 and 15 have been cancelled to avoid redundancy with amended claim 11, or to avoid improper dependency problems *vis-à-vis* amended claim 11. Accordingly, entry of the instant amendment at present is respectfully requested.

Enclosed 37 CFR § 1.132 Declaration

The attention of the Examiner is invited to the enclosed "DECLARATION UNDER 37 C.F.R. 1.132" of Mr. Yutaka Kanamaru (KANAMARU II), which provides further evidence of the non-obviousness of the present invention.

The accompanying KANAMARU II declaration shows the results of a durability test, which test was conducted in basically the same manner as described in the instant application as filed (*see page 6 of the declaration*). It is also noted that the examples in the enclosed KANAMARU II declaration are like those contained in the earlier submitted 37 CFR § 1.132 Kanamaru declaration (filed May 11, 2004), except that examples have been added in the enclosed declaration (i.e., Toners 8 and 9 are added), wherein a ratio of polyester resins contained therein is changed.

Upon review of the accompanying 37 CFR § 1.132 Declaration of Mr. Kanamaru (KANAMARU II), including data in the Table at page 7 thereof, and the results and discussion section at page 8 thereof, the Examiner will fully understand that a difference in durability exists between the toners of the cited art and those instantly claimed. The data shown in KANAMARU II provides clear and convincing evidence of the non-obviousness of the claimed invention and justifies a withdrawal of each of the outstanding 35 USC § 103(a) rejections of the present claims.

For the Examiner's convenience, the discussion of results that occurs at page 8 of Mr. Kanamaru's declaration is set forth below:

It is found from the above results that Toners 3, 4, 6, 8, and 9 each comprises a given amount of an ester wax having a low melting point, all of which give excellent results in their performances.

On the other hand, Toner 1 not containing an ester wax is unsatisfactory in low-temperature fixing ability and offset resistance, and Toner 2 containing a high-melting point wax, which is the closest example to Toner 5 of Uchida, is unsatisfactory in low-temperature fixing ability and durability.

Furthermore, Toner 7 containing a wax other than the ester wax is unsatisfactory in blocking resistance and durability even though the wax was a low-melting point wax. The reason therefor is presumably due to the lowering of the compatibility of the resin binder with the wax, as compared to that with the ester wax.

Therefore, it is clear that by the adjustment of the melting point of the wax but also the kind and the content of the wax, the obtainment of the excellent results for all of low-temperature fixing ability, offset resistance, the blocking resistance and the durability is a surprising effect which would not have been expected by one of ordinary skill in the art simply from the disclosure of Uchida.

The Examiner is respectfully requested to consider the accompanying 37 CFR § 1.132 Declaration of Mr. Kanamaru at this time, as it is material to a consideration of the patentability of the pending claims.¹

¹ If a prima facie case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. See, e.g., Dillon, 919 F.2d at 692, 16 USPQ2d at 1901. Rebuttal evidence and arguments can be presented in the specification, In re Soni, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), by counsel, In re Chu, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), or by way of an affidavit or declaration under 37 CFR 1.132, e.g., Soni, 54 F.3d at 750, 34 USPQ2d at 1687; In re Piasecki, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984).

Claim Rejections 35 USC § 112

Claims 17-18 have been rejected under the provisions of 35 USC § 112, first paragraph, as failing to comply with the written description requirement. Reconsideration and withdrawal of this rejection is respectfully requested based on the following considerations.

Each of claims 17-18 has been amended to recite the presence of a "polymerization initiator". As such the claimed invention fully complies with all provisions of 35 USC § 112.

Claim Rejections - 35 USC § 103(a)

Claims 11-16 have been rejected under the provisions of 35 USC § 103(a) as being unpatentable over Uchida et al (US 4,863,824), in view of Matsunaga et al. (US 5,976,752). Claims 11-18 have also been rejected under the provisions of 35 USC § 103(a) as being unpatentable over Aoki et al. (US 5,723,246) in view of Matsunaga et al. (US '752). Reconsideration and withdraw of each of these rejections is respectfully requested based on the following considerations.

As indicated above the Examiner is respectfully requested to consider the accompanying declaration of Mr. Kanamaru and the comparative testing results set forth therein. Upon review of the same, the Examiner will fully understand and appreciate that unexpected and advantageous results are associated with the instant

invention that are not possessed by the cited art, and that as a result, the cited art is incapable of rendering the instant invention obvious.

The achievement of unexpected and advantageous results when compared with the cited art, is an acceptable indicia for determining the non-obviousness of an invention. As stated in the MPEP at § 716.01(a):

Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)....

Additionally, With respect to the teachings of Aoki et al., it is noted that claim 11 has been amended to recite the transitional phrase "consisting of". The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as

"closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

As such, it is submitted that the cited Aoki et al. US '246 reference is incapable of rendering the present invention as recited in claim 11, and its dependent claims obvious. This conclusion does not change even upon combining the teachings of Aoki et al. US '246 with the secondary reference of Matsunaga et al. US '752, since Matsunaga et al. US '752 does not cure the deficiencies of the Aoki et al. US '246 primary reference.

Likewise regarding amended claims 17-18, the Aoki et al. US '246 reference provides no motivation or teaching regarding the toners that are recited therein and provides no motivation to arrive at the same. Such teachings and motivation are also lacking in the secondary reference of Matsunaga et al. US '752. Absent such motivation in the cited art the Examiner's outstanding rejections are not sustainable, and must be withdrawn.

As stated in § 2143.01 of the MPEP:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)....

Accordingly, reconsideration and withdraw of each of the outstanding rejections under 35 USC § 103(a) is required at present.

Conclusion

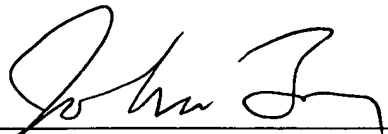
Based on the amendments and remarks presented herein, as well as the submission herewith of Mr. Kanamaru's enclosed 37 CFR § 1.132 Declaration, the Examiner is respectfully requested to issue a notice of allowance in the matter of the instant application, clearly indicating the patentability of each of instantly pending claims 11, 13-14, and 16-18.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: 37 CFR § 1.132 Declaration of Mr. Kanamaru (KANAMARU II)